

## **RESPONSE AND REMARKS**

Amendments to Claims 1 through 57 are filed concurrently herewith to more distinctly claim the invention. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested.

### SPECIFICATION

In the Office action, the Examiner objected to use of various trademarks as used in the specification and indicated that the trademarks should be capitalized wherever they appear. Responsive to the Examiner's objections to the use of trademarks, the specification, as amended, identifies trademarks used in the specification, references the proprietary nature of those trademarks through the use of the "TM" symbol, and equates the TM-designated trademark with both an all-capitalized version of the trademark and with alternative ways in which the trademarks appear in the specification.

### SECTION 112

In the Office Action, the Examiner rejected Claims 1-57 as being indefinite under 35 U.S.C. §112 on several grounds. The Examiner rejected Claims 1-3, 8-10, 15-17, 22-24, 29-31, 36-38, 43, 48, and 53, concluding that there was insufficient antecedent basis for the claimed term "each user client computer device." Amendments to the rejected claims have been made to more specifically recite antecedent basis for the claimed term "user client computer device."

In the Office Action, the Examiner objected to the term "each of a plurality of carriers" in Claims 1, 3, 8, 10, 15, 17, 22, 24, 29, 31, 36, 38, 43, 48, and 53, as indefinite. Amendments to the rejected claims recite, e.g., "each respective carrier of a plurality of carriers."

In the Office Action, the Examiner objected to the punctuation of Claims 4, 11, 18, 25, 32 and 39, and suggested alternative punctuation. Amendments to the rejected claims incorporate additional punctuation.

In the Office Action, the Examiner objected to the term "each of a plurality of services" in Claims 5, 12, 19, 26, 33 and 40, as indefinite. Amendments to the rejected claims recite "each respective service of a plurality of services."

In the Office Action, the Examiner objected to the phrase "calculate the shipping rate" in Claims 6, 13, 26, 27, 34, and 41, as indefinite, questioning whether the phrase constituted a second calculation or a further limitation. It is respectfully submitted that the respective claims have been amended to more distinctly claim the phrase "calculate the respective service-specific, carrier-specific shipping rate. . . according to . . ." is a further limitation.

In the Office Action, the Examiner objected to the term "the particular user" in Claims 7, 14, 21, 28, 35 and 42, as having insufficient antecedent basis. The rejected claims have been amended to provide antecedent basis to support the amended claimed terms.

In the Office Action, the Examiner observed that the terms "billable weight", "dimensional weight" and "ratable weight" are used in the claims, but was unclear about the definitions. The Examiner said that because no express calculations or equations were specified that, for examination purposes, the Examiner would consider the three weights to be the same.

It is respectfully submitted that, although it is possible, depending on a given carrier's rules, that one, two or all three of the three perspectives of weight could be equivalent, the present application properly describes the distinction between the three perspectives of weight in terms that apply across carriers; it is respectfully requested that the Examiner consider the below-described distinction between the three perspectives of weight during examination of the present application.

It is respectfully submitted that the three terms are not necessarily equivalent for a given carrier, depending on the given carrier's rules. The specification, including the original claims, differentiate between the three perspectives of weight, but provide for, such as with, e.g., Independent Claim 43 and two of its dependent claims, Claims 46 and 47, the equivalency of

dimensional weight with ratable weight (Claim 46), or the equivalency of billable weight with ratable weight (Claim 47), depending on a given carrier's rules.

"Dimensional weight" is a function of the physical dimensions (e.g., length, width, girth) of a parcel in view of the physical weight of the parcel. See, e.g., Specification, page 2, lines 19-24. ("One of the problems in dealing with standalone Carrier systems is that in order for a Shipper to compare services and pricing for shipping a single parcel with multiple Carriers, the Shipper must apply each Carrier's rules for calculating a 'dimensional weight' to the physical dimensions and weight of a particular parcel. Because each Carrier may limit shipping to parcels that do not exceed a particular dimensional weight, the Shipper must determine whether each of the plurality of Carriers supports shipping the particular package.")

As recited in, e.g., original Claim 4, "the calculated dimensional weight of the particular parcel calculated for each carrier" would be compared to "a set of dimensional weight limitations for the carrier." That is, not only is the calculation of dimensional weight carrier-specific, but so too is the limitation against which the calculated dimensional weight is compared. It is respectfully noted that the original claims are part of the specification and are properly considered as part of the explanation herein. See, e.g., Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 998, n.4, (Fed. Cir. 2000), *cert. denied*, 121 S. Ct. 1167 (2001) ("One of this court's predecessor courts clarified that disclosure in an originally filed claim satisfies the written description requirement. See In re Gardner, 480 F.2d 879, 880 (CCPA 1973) ("Under these circumstances, we consider the original claim in itself adequate 'written description' of the claimed invention. It was equally a 'written description' whether located among the original claims or in the descriptive part of the specification.")).

Depending on a given carrier's rules, dimensional weight may be considered in determining whether or not the given carrier will support shipment of a particular parcel; it may also be considered in determining a billable weight.

As compared to calculating dimensional weight according to physical dimensions and physical weight, an exemplary determination of billable weight is disclosed in the specification as being a selection or function [according to the particular carrier's rules] of: actual weight, dimensional weight, oversize weight or letter weight. Specification, page 58, lines 13-18.

Ratable weight may be a carrier-specific function of the parcel specifications (e.g., the physical weight of the parcel in view of the physical dimensions of the parcel) according to respective carrier-specific ratable weight determination rules. See, e.g., Specification, Original Claim 50 ("determining, in response to a request by any particular user of a plurality of users, a ratable weight for a particular parcel for each carrier from a plurality of carriers according to ratable weight determination rules for each of the plurality of carriers, wherein the particular parcel is characterized by a set of parcel characteristics input by the particular requesting user . . .").

Depending on a given carrier's rules, ratable weight may be a function, according to the given carrier's rules for rating a shipment, of dimensional weight and/or billable weight, as the weight to use in the carrier's shipment rating calculation. See Specification, page 3, lines 17-22 ("apply, in response to a request by any particular user of a plurality of users, each Carrier's rules for determining a ratable weight, including calculating a 'dimensional weight' according to physical dimensions and weight of a particular parcel, and determining a 'billable weight' according to physical dimensions, dimensional weight and actual weight of a particular parcel. . . . For each of the Carriers that support shipping the particular parcel, . . . applies the Carrier's parcel shipment pricing rules to the ratable weight of the particular parcel and to other factors regarding the Shipper's shipping requirements in order to determine a price that each Carrier would charge for shipping the particular parcel").

It is respectfully submitted that it is possible, depending upon a given carrier's rules for determining shipping rates, that some of the three perspectives of weight may, as the Examiner concludes, be equivalent. For example, in Claim 43, as amended, a computer system is claimed that applies "a respective set of

carrier-specific ratable weight determination rules, for each respective carrier" to a "respective set of parcel specifications" for a respective particular parcel; Claim 45, as amended, is directed to ". . . determine . . . a respective carrier-specific ratable weight for the respective particular parcel . . .". Amended Claim 46, which is dependent on Claim 43, recites "wherein the respective carrier-specific ratable weight is a dimensional weight." Amended Claim 47, which is also dependent on Claim 43, recites "wherein the respective carrier-specific ratable weight is a billable weight."

As opposed to describing carrier-specific rules or formulae for the three perspectives of weight, it is respectfully submitted that the specification explains the three terms in a manner that applies across carriers. Carrier-specific formulae or rules for determining the various perspectives of weight, and for determining shipping rates, may differ from carrier to carrier, and for a given carrier, may change over time. Therefore, as opposed to describing carrier-specific rules or formulae for the three perspectives of weight, the specification discloses a system that is programmed to apply each carrier's rules, however those rules may be defined at the particular time, for determining the various perspectives of weight. For example, in describing FIGS. 36c through 36d, the specification explains that, for each carrier, the System performs certain procedures, including, applying carrier business rules for calculating a dimensional weight (depicted in element 3023 of FIGS. 36c through 36d) and carrier business rules for determining billable weight (depicted in element 3024 of FIGS. 36c through 36d). The specification depicts an exemplary determination of billable weight as being a selection or some calculated combination [according to the particular carrier's rules] of: actual weight, dimensional weight, oversize weight or letter weight. See Specification, page 58, lines 13-18.

It is respectfully submitted that the explanation in the specification of the three perspective of weight terms in a manner that applies across carriers is appropriate for a system that is programmed to apply each carrier's rules, however those rules may be defined at the particular time, for determining and/or using the various perspectives of weight.

It is respectfully requested that the Examiner consider the above-described distinction between the three perspectives of weight during examination of the present application.

SECTION 101

In the Office Action, the Examiner rejected Claims 1 through 14, 22 through 35, and 43 through 52 under 35 U.S.C. §101. In rejecting these claims under Section 101, the Examiner read the claims as "not require[ing] the use of the computer system" but as "mere[ly] recit[ing]" . . . "technological arts . . . in the preamble." The Examiner concluded that the preamble of the rejected claims provided a "mere implication of employing a machine or article of manufacture to perform some or all of the recited steps" and that the rejected claims are "directed to non-statutory subject matter."

It is respectfully submitted that because reference in the preamble of each of Claims 1 through 14, 22 through 35, and 43 through 52 to "a . . . computer system" provides antecedent basis for subsequent reference to "*the* computer system" in each of Claims 1 through 14, 22 through 35, and 43 through 52, those claims are properly directed to statutory subject matter under Section 101. In particular, the preamble of each of Claims 1 through 14, 22 through 35, and 43 through 52 recites, or is dependent on a claim that recites, "a . . . computer system"; the body of the rejected claims (or a claim on which the subject claim is dependent) use as antecedent basis, recitation of "a . . . computer system" in the preamble. For example, the preamble of Claim 1 recites "A . . . computer system"; the body of Claim 1 (as amended) recites . . . "wherein each respective user accesses *the* computer system . . . ". (Emphasis added).

It is respectfully submitted that the preamble of a claim, such as the preamble of Claims 1 through 14, 22 through 35, and 43 through 52, that recites matter that breathes life into the claim should not be discounted as a mere recitation of technological arts. See Stranco Inc. v. Atlantes Chemical Systems Inc., 15 U.S.P.Q.2d 1704, 1713 (S.D. Tex. 1990) ("The fact that a preamble is necessary to provide antecedent basis for subsequent language in the claim is

significant in determining that the preamble is a claim limitation.""); see *also*, Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997) ("Where a patentee uses the claim preamble to recite structural limitations of his claimed invention, the PTO and courts give effect to that usage. . . ."). In the present case, because the preamble of Claims 1 through 14, 22 through 35, and 43 through 52 provides antecedent basis for subsequent language of the claims, the claim preamble of each respective claim is properly taken into account when interpreting each claim.

Taking the preamble of each respective claim into account, it is respectfully submitted that Claims 1 through 14, 22 through 35, and 43 through 52 are directed to statutory subject matter under 35 U.S.C. §101 because they are expressly directed to a computer system, or a method using a computer system, as the case may be.

Further, as the Examiner agrees, Claims 1 through 14, 22 through 35, and 43 through 52 are directed to a practical application in the technological arts, the purpose of which is to produce a real world useful result, namely, *e.g.*, "calculated rates for carriers used in selecting a specific service for shipping ... ". Office Action, page 6, topic number 17. Therefore, Claims 1 through 14, 22 through 35, and 43 through 52 are directed to statutory subject matter under 35 U.S.C. §101. See, *e.g.*, State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 1373 (Fed. Cir. 1998) (citations omitted) ("Congress intended §101 to extend to 'anything under the sun that is made by man.'"); *id.* at 1372 ("The plain and unambiguous meaning of §101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§102, 103 and 112, P.2, n. 2."); MPEP §2106 II, A (the "purpose of this [section 101] requirement is to limit patent protection to inventions that possess a level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept."); *id.* ("[Patent] Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of

abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.").

Further, the claims rejected under section 101 have been amended to expressly recite that the claimed computer system comprises at least one computer device.

For the above reasons and authorities, it is respectfully submitted that Claims 1 through 14, 22 through 35, and 43 through 52, as amended, are directed to statutory subject matter under 35 U.S.C. §101; it is respectfully requested that Claims 1 through 14, 22 through 35, and 43 through 52, as amended, be reconsidered.

#### SECTION 102

In the Office Action, the Examiner rejected Claims 1-6, 8-13, 15-20, 22-27, 29-34, 36-41, and 43-57 under section 102(b) as being unpatentable over Nicholls et al. (U.S. Patent No. 5,485,369; "Nicholls").

It is respectfully submitted that the Claims, as amended, are patentably distinct from the cited reference, alone or in combination with any other reference of record.

First, as compared to the claims of the present application which are directed to a system, method, or computer program product, as the case may be, that is receptive to, and/or responsive to, each respective user of a plurality of users, Nicholls is not directed to multiple users. Rather, each Nicholls system must be "preprogrammed [with a] set of rules which are reflective of a *given shipper's predefined set of shipping requirements*." Nicholls, Col. 2, lines 31-34 (emphasis added). See also, Nicholls, Col. 1, lines 59-61 ( ". . . facilitates the process of shipping goods by a shipper having a predefined set of shipping requirements via a carrier having a predefined rate structure." (Emphasis added)); Nicholls at Col. 4, lines 55-60 ("The presently preferred embodiment facilitates the particular Shipper's requirements . . . in one or more client



applications. *These client applications may be customized to conform quite closely to a given shipper's operation.*" (Emphasis added)).

As compared to being pre-programmed to reflect a *given* shipper's pre-defined set of shipping requirements as with Nicholls, the claims of the present application are directed to a system, method or computer program product, as the case may be, that is receptive and responsive to a *plurality* of users.

As recited, for example, in amended Claim 1, the claimed computer system is programmed to "receive from each respective user of a plurality of users, a respective input of a respective set of parcel specifications for a respective particular parcel . . .", Further, as recited in amended Claim 1, "each respective user accesses the shipping management computer system over a global communications network using a respective user client computer device..." that is itself "adapted for communication with the global communications network."

As is further recited in amended Claim 1, in response to each respective input from each respective user, the computer system is programmed to "apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers, to the respective set of parcel specifications . . .".

In order to be receptive to and responsive to each respective user of a plurality of users, the claimed system must be able to both keep track of each respective user's input, and perform the claimed action, which in the case of Claim 1, is to " apply a respective set of carrier-specific dimensional weight calculation rules, for each respective carrier of a plurality of carriers. . .", with respect to each respective user's input of a respective set of parcel specifications for a respective particular parcel. Nicholls simply does not disclose processing information from more than one user at a time.

It is respectfully submitted that because, as explained above, Nicholls is not directed to multiple users, Nicholls does not disclose, anticipate, or suggest, alone or in combination with any other reference of record, the amended claims that are directed to carrier-specific rules for determining and/or using one or more

of a dimensional weight, a billable weight, and a ratable weight with regard to a respective set of parcel characteristics or specifications for a respective parcel, said respective set of parcel characteristics or specifications input by a respective user of a plurality of users, wherein each respective user accesses the system via a global communications network, such as the Internet.

Further, because, as explained above, Nicholls is not directed to multiple users, Nicholls does not disclose, anticipate, or suggest, alone or in combination with any other reference of record, the amended claims that are directed to generating an online comparison display of service-specific, carrier-specific shipping rates that were calculated by the system to a respective display monitor configured with the respective client computer device of the particular respective user.

As further distinguished from Nicholls, the amended claims of the present application are directed to applying each carrier's own rules for calculating, determining, and/or using dimensional weight, billable weight, and/or ratable weight. The Examiner correctly cites Nicholls' disclosure of an "I/O Token" named "DIMWT" that is described as "dimensional weight" (Nicholls, Cols. 21-22, line 65). The Examiner cites Nicholls at Col. 5, lines 34-40 ("... servers such as rate servers encode the knowledge required to answer questions such as how to calculate shipment rates or how to band shipments. Thus, rate servers provide the knowledge regarding a specific carrier's requirements. ") to support the proposition that Nicholls discloses "determining a dimensional weight . . . and us[ing] the weight to calculate rates for the shipment." However, it is respectfully submitted that the disclosure by Nicholls to "calculate shipment rates" and "provide the knowledge regarding a specific carrier's requirements" does not disclose use of carrier-specific dimensional weight calculation rules as recited by the amended claims.

The Examiner also cites Nicholls at Col. 25-26, line 39 (an "I/O Token" named "DIMRATE" that is described as a Boolean field ("1" or "0"), the value of which is described as "use dimensional rating") to support the proposition that Nicholls discloses "determining a dimensional weight . . . and us[ing] the weight

to calculate rates for the shipment." However, it is respectfully submitted that an "I/O Token" that signals "use dimensional rating" does not disclose the subject matter of the claims as amended that recite use of carrier-specific dimensional weight calculation rules and/or use of service-specific, carrier-specific parcel shipping pricing rules (see, e.g., Claim 6).

Further still, there is no disclosure in Nicholls, alone or in combination with any other reference of record, of a comparison of a dimensional weight, however that dimensional weight may have been determined, against a carrier-specific dimensional weight limitation, as claimed in, e.g., Claims 4, 11, and 21 of the present application, to identify carriers that would support shipping a particular parcel. Similarly, there is no disclosure in Nicholls, alone or in combination with any other reference of record, of an identification of carriers that would support shipping a particular parcel according to a calculated respective carrier-specific dimensional weight for the respective carrier, and according to a respective carrier-specific dimensional weight limitation for the respective carrier, as claimed in, e.g., Claims 2, 9, and 16.

Further, as previously explained above, a billable weight or a ratable weight, can, depending on a given carrier's rules, be distinct from a dimensional weight for that carrier. It is respectfully submitted that Nicholls, alone or in combination with any other reference of record, does not disclose, anticipate, or suggest, a system that calculates, determines and/or uses, a billable weight or a ratable weight as claimed in Claims 22 through 57.

Accordingly, it is respectfully submitted that Nicholls, alone or in combination with any other reference of record, does not disclose, anticipate, or suggest, the subject matter of the amended claims of the present application.

### SECTION 103

In the Office Action, the Examiner rejected Claims 7, 14, 21, 28, 35, and 42 under 35 U.S.C. 103(a) as being unpatentable over Nicholls in view of Kara et al. (U.S. Patent No. 6,233,568; "Kara").

First, for the reasons given above, it is respectfully submitted that Nicholls, alone or in combination with any other reference of record, does not disclose, anticipate, or suggest, the subject matter of the amended claims of the present application. Further, the Examiner concluded that the section-103-rejected claims were unpatentable over Nicholls in view of Kara on the grounds that "Kara discloses a computer program used for multiple shippers that displays that [sic] calculate shipping rates of multiple carriers for multiple services (citing Kara, FIG. 8, and Kara, col. 22, lines 20-38). However, Kara does not disclose, anticipate, or suggest, alone or in combination with any other cited reference, a display of shipping rates for a plurality of services offered by a plurality of carriers where, as in the case of the section-103-rejected claims, the shipping rates were calculated only after comparing carrier-specific dimensional weights to a carrier-specific dimensional weight limitation.

The section-103-rejected claims are dependent claims that are directed to generating a display of shipping rates -- the shipping rates that are to be displayed, e.g., in Claim 7, were calculated only after comparing (in Claim 4) carrier-specific dimensional weights (that were calculated in Claim 3) to a carrier-specific dimensional weight limitation (in Claim 4). There is no disclosure in either Kara or Nicholls of displaying shipping rates for a plurality of services offered by a plurality of carriers where, as in the case of the section-103-rejected claims, the shipping rates were calculated only after comparing carrier-specific dimensional weights to a carrier-specific dimensional weight limitation.

Accordingly, it is respectfully submitted that neither Kara nor Nicholls, alone or in combination with each other or with any other reference of record, disclose, anticipate, or suggest, the subject matter of the amended claims of the present application.

As further distinguished from Kara nor Nicholls, alone or in combination, the section-103-rejected claims of the present application are directed to a display of calculated shipping rates for each service of a plurality of services offered by each supporting carrier of a plurality of carriers. As compared to calculating shipping rates for each service of a plurality of services offered by

each supporting carrier of a plurality of carriers, in Kara, the "program automatically calculates the [shipping] fees for each shipping service provider offering service commensurate with the desired shipping and/or delivery parameters." Kara, col. 22, lines 39 – 42. That is, the user must first indicate a type of service (e.g., Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day); Kara discloses then calculating the shipping rate for each carrier that supports the selected type of service; only one rate per carrier is calculated.

Accordingly, it is respectfully submitted that neither Kara nor Nicholls, alone or in combination, disclose, anticipate, or suggest the subject matter of the amended claims of the present application.

For the foregoing reasons and authorities, because independent Claims 1-3, 8-10, 15-17, 22-24, 29-31, 36-38, 43, 48, and 53, (as amended), are patentable over the cited references, Applicant respectfully submits that dependent Claims 4-7, 11-14, 18-21, 25-28, 32-35, 39-42, 44-47, 49-52, and 54-57, are therefore also patentable over the cited references.

In view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully submits that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

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